

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Rejection under 35 USC § 102

The rejection of claims 1-5, 10-11 and 17-21 under 35 USC § 102(b) as being anticipated by Geelen, is respectfully traversed.

In this rejection the position is taken that Geelen discloses an index. It is indicated that an index is, for the sake of rejection, considered to be "a listing of information" and that Figs. 4 and 9-10 show what is considered to be indexes. Further, column 4, lines 1-6 and column 7, lines 49-56 are cited to support the position that Geelen discloses the claimed subject matter.

However, column 7, lines 49-56, discloses:

When the printing operation is performed, the job splitting unit 22 will read the **data sequence** shown in Fig. 9A out of the memory 20, exercise the **separators** 44-52 from the **data stream**, and assemble the **data sequences** for the two sub-jobs, which are shown in Figs. 9B and 9C and will be **delivered to the buffers** 24 in accordance with the printing units designated by the user. (Emphasis added)

Thus, what is shown in Fig. 9A is therefore data which will be printed and which has been subdivided by separators 44-52 which mark the beginning and end of blocks of data that will be sent to a printer or printers and subsequently printed out. The fact that what is shown in Fig. 9A is such as to have parts "removed" indicates that what is shown, is not an index (a listing of information as per the position taken in this rejection) but a depiction of the data which is lined up ready for printing and which has been blocked out by the insertion of removable "separators." The fact that parts can be

“excised” (viz., removed) in a manner to leave a data stream is such as to clearly distinguish this from a “listing of information.” That is to say, what parts of a list can be removed and what part remains, and is what remains still a list if the separators, which were necessary in order to create the “list”, are now gone?

In the rejection of claim 1, it is stated that creating an index of information relating to the locations of the pages in the print job is anticipated by the disclosure of Geelen which indicates that “. . . a sequence of data which represents the jobs (job 1, job 2 etc.) which have been sequentially received from the host 12 and are stored in memory 20. Each of these blocks may stand for a certain range of pages. . .”

However, the sequence data is not part of a “listing of information” but the data stream that will be fed to the printer. It goes without saying that this will be stored in memory, in that if were not stored, there would be nothing to print. Of course the blocks of data will represent certain pages or a range of pages – it must – if there is going to be anything to print. It is also self-evident, that if the sequence of data is the index then there is no print job left.

How is the step of “determining if the pages in the print job meet a criteria based on the information in the index” performed, if the index is in fact the pages in the print job?

There is no disclosure of a listing of information (viz., creating an index) that represents the location of the pages in the print job generated and certainly no determination if this index is screened to determine if the pages in the print job meet a criteria based on the information in the index. Indeed, as note above, how does the step of “determining if the pages in the print job meet a criteria based on the information in the index” if the index is the pages in the print job?

In the rejection, this feature is alleged to be anticipated by “the splitting criteria is the number of pages.” While this is not particularly clear, it appears to taken out of context. Fig. 12 depicts a “line printer job splitter profile editor.” Further, there is no disclosure of this number of pages being compared with a listing of information (viz., an

index as per the position taken by the PTO in the rejection), as per the claimed requirements.

This rejection is also traversed in that it is a method claim and in order to anticipate it, all of the claimed steps must be shown to be disclosed.

Claim 1 calls for “creating” an index of information. It is submitted that the rejection has held up bits and pieces and asserted that the bits and piece amount to an index. However, the “creation” of this index has not been identified. Presumably, thought will immediately fly to the insertion of the separators 44-52. However, this, while being possibly considered subdividing the print data stream, is merely a “subdivision” of data and is not at all discernable as being “creating” a “list of information.” Further, the data is the print job – so where’s the index? – if it’s the index then where is the print job? Clearly it is impermissible for the print job to simultaneously be the index without committing impermissible double inclusion.

In connection with claim 17, the shortcoming of the interpretation of what is disclosed in Geelen becomes even more evident. That is to say, it is stated that “in Fig. 9A, one can see that separators (such as 44, 46, 48, 50 and 52 of Fig. 9A) are created to separate various parts of the job (each one of which can be one or more pages).” this should be compared with “creating an index.”

It is further asserted that Geelen discloses “. . . the job splitting unit 22 has modified the original data sequence shown in Fig. 4 by inserting additional sub-job separators 44-52.” This “modifying the original data sequence” should be contrasted with “creating an index.”

In the Applicant’s position, none of this amounts to a creation of a “list of information” relating to the location of the pages in the print job. Besides, if the collection of separators and blocks of data are the list – then where is the print job? – note being had to the fact that Geelen discloses Fig. 9A as “showing the data sequence of Fig. 4 after the first job has been split into two sub-jobs.”

Rejections under 35 USC § 103

- 1) The rejection of claims 6-9 under 35 USC § 103(a) as being unpatentable over Geelen in view of Zingher is traversed.

A rejection under § 103 requires that a *prima facie* case of obviousness be established. In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

It is submitted that the index which is claimed would not under any circumstances be rationally seen by the hypothetical person of ordinary skill as being suggested by the arrangements shown in Figs. 9, 10 and 11 of Geelen. What can be irrationally advanced in a § 102 rejection as being "considered" what is claimed, no longer has any value under § 103, and the key is what consideration would the hypothetical person of ordinary skill give to the disclosure of the reference or references when taken as a whole. What "can be considered indexes" for no particular reason, now must be disclosed or suggested as being indexes. If there is no disclosure or suggestion then there is no *prima facie* case. The addition of the Zingher teachings does nothing to resolve this shortcoming in disclosure and the rejection cannot be seen as being tenable in any shape or form.

- 2) The rejection of claims 13-16 under 35 USC § 103(a) as being unpatentable over Geelen is traversed.

This claim is even less tenable than that discussed above for at least the reasons discussed above. Attention is also called to page 11 wherein it is stated in connection with scanning for print job for page markers in claim 16, that "Geelen discloses in column 7, lines 38-48 that various separators separate the different sub-jobs of a job. If each sub-job only had 1 page, the sub-job separators effectively become page separators (or markers)."

However, these separated print-jobs are what is purported to be the index and thus seen as ruinous to the tenability of both the § 103 and § 102 rejections.

Conclusion

The claims as they stand before the Patent Office are deemed to be patentable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

Date: \_\_\_\_\_

09/12/2005

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